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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/687,116 | 10/17/2003 | Fumito Nariyuki | FS-F03210-01 | 7360 |

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TAIYO CORPORATION
2111 JEFFERSON DAVIS HIGHWAY
#412, NORTH
ARLINGTON, VA 22202

| EXAMINER | |
|---|---|
| CHEA, THORL | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1752 | |

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/687,116 | NARIYUKI, FUMITO | |
| | Examiner | Art Unit | |
| | Thorl Chea | 1752 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *17 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This is the first office action responsive to the filing of this instant application. Claims 1-17 are pending in this instant application.

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the scale in the Absorption axe in Fig. 1 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-8, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Uytterhoeven et al (US Patent N 6,143,488). See the composition of the photothermographic material wherein at least 80 mole % of the photosensitive silver halide is silver iodide in the abstract; in the preferred embodiment wherein at least 80 % by number of the photosensitive halide particle having a diameter of less than 40 nm. See also the composition of the material in column 20, claim 1 and the exemplified samples in Table 7 in column 20 and the process for froming an image in column 14, lines 28-40. The teaching of Uytterhoeven et al meets the limitation of the claimed invention, and therefore, the invention as claimed lacks novelty. The limitation such as "thermal development is started within 60 second after exposure" is related to the use of the material in the process for forming an image and fails to further limit the composition of the material.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 9, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uytterhoeven et al (US Patent N 6,143,488) in view of EP 1096310 A2 (EP'310) or Matsumoto et al (US Patent No. 5,958,668).

The teaching of Uytterhoeven et al is as shown in the paragraph 3 above. Matsumoto et al disclose the compound of formula (H) in claim 8 in column 6, lines 26-50; in column 2, formula (A); the reducing agent of formula R in claim 11 in column 18. The hydrogen-bonding compound and the development accelerator have been known and taught in EP'310 on page 20-34 and 44-48. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the compound taught Matsumoto et al and EP'310 in the material of Uytterhoeven et al to improve its fogging property and increase the speed of development thereof, and thereby provide the invention as claimed.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uytterhoeven et al (US Patent N 6,143,488) in view of Farid et al (US Patent No. 5,747,236) or Asanuma et al (US Patent No. 6,686,140). The teaching of Uytterhoeven et al is as shown in the paragraph 3 above, but fails to disclose the compound that can be one-electron-oxidized to provide a one-electron oxidation product which releases one or more electrons. The compound however known in Asamuma et al in column 6, Type 1 to Type 5, and Farid in the abstract. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the known compound taught in either Farid et al or Asanuma to provide the material of Uytterhoeven et al with high photographic speed and low fog, and thereby provide an invention as claimed.

8. Claim 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uytterhoeven et al (US Patent N 6,143,488). Uytterhoeven et al disclose the recording process using UV light and laser diode in column 11, lines 15-34. It would have been obvious to use the laser beam suggested therein to record an image, and thereby provide a process as claimed.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uytterhoeven et al (US Patent N 6,143,488) as applied to claims Uytterhoeven et al (US Patent N 6,143,488) above, and further in view of Yip (US Patent No. 5,817,447). Yip discloses the recording process using laser having wavelength in the blue or in the UV region in the abstract and column 4, claim 2, wherein the laser having wavelength of less than 460 nm. It would have been obvious to use the laser having wavelength in the blue or UV region known in Yip and suggested in Uytterhoeven et al, and thereby provide a process as claimed.

10. Claims 1-5, 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamane et al (Pub. No. 2003/00118953).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See the material of Yamane et al on page 47, claims 1-6, and 9-27 which discloses the material of same composition such as silver iodide content and process using light of the same wavelength.

11. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukui et al (Pub. No. 2003/0207216A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. See the pages 55-57, claims 1-16 wherein the silver halide contains same content of the silver iodide.

12. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Oka et al (Pub. No. 2003/0232288 A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. See the pages 192-195, claims 1-55 wherein the silver halide contains same content of the silver iodide.

***Double Patenting***

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-5, 7-9, 14-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10/191,485. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention and the invention claimed in the invention claimed in the copending application are directed to the use of the silver halide having same silver iodide content and the process using irradiation of the same wavelength.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-5, 7-9, 14-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/403,006. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed material and the material claimed in the copending application use of the silver halide having same silver iodide content and the process using irradiation of the same wavelength, and the diazine compound used in the claims of the copending application has been known in the art as toning agent for photothermographic material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-5, 7-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of copending Application No. 10/285,644 in view of Farid et al (US Patent No. 5,747,236). The claimed invention and the invention claimed in the invention claimed in the copending application are directed to the use of the silver halide having same silver iodide content, and the compound claimed in the copending application has been known as spectral sensitizer taught in Farid et al, and the use thereof to increase the spectral sensitivity of the halide emulsion claimed in the copending application would have been found obvious to the worker of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

***Conclusion***

17. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea
January 7, 2005

Thorl Chea
Primary Examiner
Art Unit 1752